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Paper No. 6

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JUL 07 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Ono)
Application No. 09/873,649) **DECISION ON PETITION TO**
Attorney Docket No. A3156.0022/PO22) **WITHDRAW HOLDING OF**
Filed: June 4, 2001) **ABANDONMENT UNDER 37 CFR**
For: INTEGRATED CIRCUIT FOR) **§1.181**
MODEM)

This is a decision on the petition, filed April 9, 2004, by Mr. Steven I. Weisburd requesting the Withdrawal of the Holding of Abandonment of the above-identified application. The petition is being considered under 37 CFR §1.181. This application was held abandoned for failure to respond to the Office action mailed September 23, 2003 (Paper No. 3). A Notice of Abandonment was mailed on March 31, 2004 (Paper No. 4).

Evidence in Support of Petition

In support of the petition, Mr. Weisburd has provided a declaration that the Office action was not received; that the practitioner filed a change of address "on or about February 6, 2002"; and that the practitioner became aware of the Office action when the examiner contacted the practitioner (date not specified). The petition further contains a statement from the practitioner that a search of the file jacket and the docket records indicates the Office action was not received. A copy of the Dickstein docket record has been included.

The petition states Mr. Weisburd transferred his practice from Ostrolenk Faber Gerb & Soffen, LLP (hereafter "Ostrolenk") to the firm of Dickstein Shapiro Morin & Oshinsky, LLP (hereafter "Dickstein") on January 2, 2002. Subsequent to the change in firms, an employee of Dickstein, Mr. David Andres, picked up mail received for Mr. Weisburd at Ostrolenk. A declaration by Ms. Henrietta Marron has also been included regarding the Dickstein docketing records.

Issues Involving Address Changes

Unraveling this file's address change and powers of attorney is complicated by the practitioners' use of a customer number. A review of the file jacket reveals an original declaration that set forth the address of record as

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Customer No. 2352

There is no evidence found relating to the filing of a change of address and Mr. Weisburd has not provided any additional proof of a change of address filed after January 2002. In addition, there

is no statement made relating to changes associated with the customer number for this application.

The following guidelines were set forth in the Official Gazette Notice, 1191 OG 187, "Extension of the Payor Number Practice (through 'Customer Numbers') to Matters Involving Pending Patent Applications" dated October 15, 1996.

As the PTO will not recognize more than one correspondence address (37 CFR 1.34(c)), any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application would be resolved in favor of the address of the Customer Number. Where an applicant appoints all of the practitioners associated with a Customer Number as well as a list of individually named practitioners such action would be treated as only an appointment of all of the practitioners associated with a Customer Number due to the potential for confusion and data entry errors in entering registration number from plural sources.

Essentially, it is reasonable to assume Mr. Weisburd could not correct the correspondence address via separate letter once the customer number was established for this application. Any changes to the correspondence address would need to be made by updating the customer number information.

The practitioner is invited to provide copies of the information submitted to the Office relating to the change of address and the customer number to determine whether the Office in fact made a mistake. Absent a showing by the practitioner that an Office error occurred in the the correspondence address associated with Customer Number 2352; the address is presumed to be correct, Mr. Weisburd's statements notwithstanding.

Issues involving Nonreceipt of Correspondence

All of this is still secondary as to the proof necessary set forth in MPEP §711.03(c), the showing required to establish nonreceipt of an Office action includes the following:

- 1) *a statement from the practitioner that the Office action was not received,*
- 2) *a statement from the practitioner that the file jacket and docket records were searched,*
- 3) *a copy of the docket record at the address of record, and*
- 4) *a reference to the docket record in the practitioner's statement.*

[Emphasis added.]

The petition fails to fully comply with the requirements set forth above. Mr. Weisburd's evidence fails because it relates to matters involving the firm of Dickstein, while the Office action was mailed to Ostrolenk based upon the address associated with the customer number. Therefore, the evidence submitted to date has not overcome the presumption of receipt.

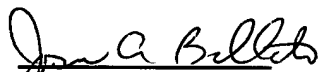
In fact, there is clear evidence the Office communication was, in fact, received at the address for Ostrolenk. The Office action of September 23, 2003 has been returned to the Office and has been found in the file wrapper. While this seems to confirm nonreceipt by the practitioner (see MPEP § 707.13), a close review of the returned envelope suggests the problem is not based upon an Office failure to use a proper address or upon a failure of the US Postal Service to deliver the communication. Rather, the markings on the envelope suggest that the Ostrolenk firm was employing the services of "Morgan Stanley Mail Services" **who did not deliver the package to Ostrolenk** because the "Addressee can not be located in the directory." The full label reads, "Mail Services received the attached item from your company. Please be informed that this item is being returned for the reason indicated below: [Box marked] Addressee can not be located in

directory. We are sorry for any inconvenience this may have caused. Your records should be updated to prevent future communications from being returned." Such a statement even suggests there was no reason to believe that the action would reach applicant with a remailing. Therefore, the evidence appears to confirm receipt, but not necessarily delivery to the address of record.

The practitioner may wish to consider providing proof of the filing of a change of address prior to the mailing of the September 23, 2003 communication. Such proof should include evidence that the customer number was being updated along with the address change and change in powers of attorney. In addition, the practitioner will need statements from the firm of Ostrolenk explaining mail delivery and the processing of mail by Morgan Stanley Mail Services at the time of the mailing of this Office communication in order to explain the nondelivery of the Office communication.

The petition is **DISMISSED**. Since the Office still does not have a proper change of address for Mr. Weisburd, this decision is being mailed to the Ostrolenk address with a courtesy copy being sent to Dickstein.

Petitioner is being granted an additional opportunity to resolve the issues raised in this decision within two (2) months of the mailing date of this decision. In the alternative, the petitioner may wish to consider filing a petition to revive under 37 CFR § 1.137. Telephone inquiries should be directed to the undersigned at (703) 308-0269.



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